

REMARKS

Reconsideration of the above-identified application in view of the preceding amendments and following remarks is respectfully requested. Claims 1-18 are pending in this application. By this Amendment, Applicants have amended Claims 1 and 13 to more particularly point out and define the subject matter regarded as inventive. No new matter has been added to the subject application, nor has any new issue been raised by these amendments. Support for the amendments herein can be found throughout the specification and drawings of the subject application.

In the office action the Examiner rejected Claims 1-9 and 13-17 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner noted that:

Claim 1 recites "storing a list comprising identifiers corresponding to specified items" in lines 10-11. It is unclear if these specified items are the same items specified by the customer order or a new set of items, making the scope of the claim vague and indefinite. Claims 2-9 inherit the deficiencies of Claim 1 through dependency and, as such, are rejected for the same reasons.

Claim 13 recites the limitation "the sub-orders" in line 2. There is insufficient antecedent basis of this limitation in the claim. Claims 14-17 inherit the deficiencies of Claim 13 through dependency and, as such, are rejected for the same reasons.

In response to this rejection, Applicants have amended Claims 1 and 13. Claim 1 has been amended to indicate that the stored list of identifiers is for the plurality of items specified by the customer and not for a new set of items. Claim 13 has been amended to replace the term "sub-order" with package.

It is respectfully submitted that these amendments to Claims 1 and 13 obviate the rejections made by the Examiner under 35 U.S.C. 112, second paragraph, to Claims 1-9 and 13-17 and an action acknowledging the same is respectfully requested.

In the Office Action the Examiner rejected Claims 1, 3-5, 9-10, 12-14 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Keong, U.S. Patent Publication No. 2005/0102203 in view of Bruns, U.S. Patent Publication No. 2005/0102203.

Keong discloses an order-handling inventory management system that includes a database that is capable of containing information about the products. This information includes availability and location of the products when these products are stored in a warehouse. A radio frequency subsystem uses radio frequencies to detect identifiers that are on the products stored in the storage site. An order-receiving-processing subsystem receives orders for products and ascertains from the database the availability and the location of the products in the storage site. A handheld RF scanner, which is part of the radio frequency subsystem, is used to detect the products within the storage site by detecting the identification of the products.

In a representative example disclosed in Keong, the database includes information, such as, the dimensions of the product, its volume and its weight. Using the physical information of each product in the customer's order, the order-receiving-processing subsystem calculates the total volume and weight of the customer's order. This calculation

enables the system to match the order with a minimum-sized package that is necessary to contain the order, avoiding the situation where unnecessarily large packages are used to ship small amounts of product. As a result, the shipping cost for delivering a single package containing the entirety of the customer's order can be minimized.

Bruns discloses a method of splitting a line item that includes storing first criteria, for splitting the line item into a plurality of deliveries, and second criteria. The method also includes generating the plurality of deliveries according to the first criteria. More specifically, Bruns discloses an order fulfillment system 10 that includes an order entry and execution function 14 and a planning function 22 connected by a core interface (CIF) 18. Order entry and execution function 14 receives sales orders that contain a customer's delivery requirements. The delivery requirements include a quantity of a product and a date the customer expects to receive the product. Order entry and execution function 14 checks the availability of stock and schedules the line items where stock is or will be available. The sales order information is duplicated via CIF 18 into planning function 22 for planning. When the planned deliveries are received back from planning function 22, order entry and execution function 14 executes the deliveries.

Planning function 22 plans the availability of material to meet customer orders or the availability of capacity to deliver the customer orders. For example, planning function 22 plans the amount of material that will be available at certain times or planning function 22 plans the availability of transportation to ship the product to a customer once it is available. Planning function 22 plans deliveries based on the delivery requirements, the availability of on-hand of material (or capacity) and the scheduled replenishment of material into stock (or capacity). (See Paragraph [0016] of Bruns). Process 30 processes (34) splitting criteria (128)

within planning function 22 (FIG. 4). Process 30 can generate new splitting criteria, modify existing splitting criteria, or delete existing splitting criteria. The splitting criteria include a threshold value and a delivery parameter. The threshold value is the type and value that determines when splitting deliveries will occur. For example, the threshold value can be a weight value (e.g., 50 tons) or a quantity value (e.g., 50 widgets).

In contrast, Claim 1 of the present invention is directed to a method for automatically selecting and packaging items for mailing that includes the steps of: storing item characteristics for a plurality of items; storing postal costs for packages based on package characteristics; receiving a customer order specifying a plurality of items for a shipment, the shipment comprising at least one package; storing a list comprising identifiers corresponding to the plurality of items specified by the customer; automatically determining a number of packages comprising the shipment and determining which items of the customer order will be contained in each package; the determining step carried out based on the identifiers, the stored item characteristics corresponding to the identifiers and the postal costs for packages.

Contrary to the Examiner's suggestion, Keong and Bruns do not disclose, either alone or in combination, Applicants' invention as recited in Claim 1. More specifically, neither of these references disclose the step of automatically determining a number of packages comprising the shipment and determining which items of the customer order will be contained in each package; the determining step carried out based on the identifiers, the stored item characteristics corresponding to the identifiers and the postal costs for packages. Keong does disclose storing data relating to postal cost in a database, but the data is used strictly to determine the shipping cost for the package so that it can be provided to customers in real-time and is not used to determine the number of packages in the shipment. Although,

Bruns discloses using facts such as product weight and/or quantity to determine the number of shipments to made in order to fulfill a customer's order, Bruns does not disclose using postal costs to determine the number of packages in a shipment.

Therefore, it is respectfully submitted that Claim 1 and each of the claims depending therefrom, namely claims 2-9 are patentable over Keong in combination with Bruns, and an action acknowledging the same is respectfully requested.

Concerning the Examiner's rejection of Claims 10, this claim is directed to a system for selecting and packaging items for mailing that includes, among other elements, a processor and a memory connected to the processor, the memory storing data and instructions for controlling the operation of the processor. The processor is operative to perform the steps of: storing item characteristics for a plurality of items; storing postal costs for packages based on package characteristics; receiving a customer order specifying a plurality of items for a shipment; storing a list comprising identifiers corresponding to items to comprise the shipment; automatically determining a number of packages comprising the shipment and determining which items of the customer order will be contained in each package; the determining step carried out based on the identifiers and the postal costs for packages.

Contrary to the Examiner's suggestion, Keong and Bruns do not disclose, either alone or in combination, Applicants' invention as recited in Claim 10. More specifically, neither of these references teach, suggest or disclose automatically determining the number of packages comprising the shipment and determining which items of the customer order will be contained in each package; the determining step carried out based on the identifiers, the stored item characteristics corresponding to the identifiers and the postal costs for packages.

Keong does disclose storing data relating to postal cost in a database, but the data is used strictly to determine the shipping cost for the package so that it can be provided to customers in real-time and is not used to determine the number of packages in the shipment. Although, Bruns discloses using facts such as product weight and/or quantity to determine the number of shipments to make in order to fulfill a customer's order, Bruns does not disclose using postal costs to determine the number of packages in a shipment.

Therefore, it is respectfully submitted that Claim 10 and each of the claims depending therefrom, namely claims 11-18 are patentable over Keong in combination with Bruns, and an action acknowledging the same is respectfully requested.

In the Office Action the Examiner rejected Claim 2 and 11 under 35 USC 103(a) as being unpatentable over Keong in view of Bruns as applied to Claims 1 and 10 above, in further view of Official Notice. Official Notice was taken that it is old and well known in the art to employ pre-printed forms for mail order. Applicants note that this Official Notice does not cure the deficiencies of the combination of Keong and Bruns noted above with respect to Claims 1 and 10. Therefore, it is respectfully submitted that Claims 2 and 11, by virtue of their dependency from Claims 1 and 10 are in condition for allowance and an action acknowledging the same is respectfully requested.

In the Office Action the Examiner rejected Claim 6-7 and 15-16 under 35 USC 103(a) as being unpatentable over Keong in view of Bruns as applied to Claims 5 and 14 above, in further view of Farmer, U.S. Patent No. 2,276,293. Farmer discloses an improved system and apparatus for selecting and assembling articles stored in different locations. Farmer does not cure the deficiencies of Keong and Bruns noted above with respect to Claims 1 and 10 from which Claims 5 and 14 respectively depend. More specifically, Farmer does not teach,

suggest or disclose automatically determining the number of packages comprising the shipment and determining which items of the customer order will be contained in each package; the determining step carried out based on the identifiers, the stored item characteristics corresponding to the identifiers and the postal costs for packages.

Therefore, it is respectfully submitted that Claims 6-7 and 15-16 by virtue of their dependency from Claim 1 and 10, and the claims depending therefrom, namely claims 8 and 17 are in condition for allowance and an action acknowledging the same is respectfully requested.

In the Office Action the Examiner rejected Claim 8 and 17 under 35 USC 103(a) as being unpatentable over Keong in view of Bruns and Farmer as applied to Claims 7 and 16 above, in further view of Official Notice. Official Notice was taken that it is old and well known in the art to shrink wrap each of the packages in plastic wrap so that an address and message are readable through the plastic wrap. Applicants note that this Official Notice does not cure the deficiencies of the combination of Keong, Bruns and Farmer noted above with respect to Claims 7 and 16. Therefore, it is respectfully submitted that Claims 8 and 17, by virtue of their dependency from Claims 7 and 16 are in condition for allowance and an action acknowledging the same is respectfully requested.

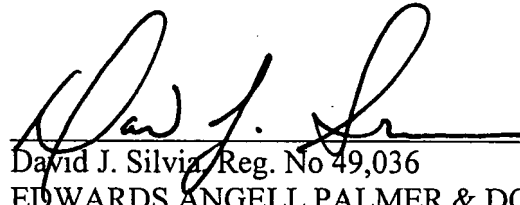
Based upon the foregoing, it is respectfully submitted that none of the prior art of record, alone or in combination, teaches, suggests, or discloses the invention recited in Claims 1-18 as presently presented. It is respectfully submitted that Claims 1-18 are in condition for allowance and an action acknowledging the same is respectfully requested.

If after reviewing this amendment, the Examiner believes that a telephone interview would facilitate the resolution of any remaining matters the undersigned attorney may be contacted at the number set forth herein below.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 303272-69331.

Respectfully submitted,

Date: April 21, 2008



David J. Silvia, Reg. No 49,036
EDWARDS ANGELL PALMER & DODGE LLP
P.O. Box 55874
Boston, MA 02205
Attorneys for Applicant
Tel.: (203) 353-6839
Fax: (617) 439-4170